

R E M A R K S

Reconsideration of this application is requested.

Claims 1, 3, 4, 6-8 and 12-14 are now in the application.

Priority

Applicant acknowledges the Examiner's statements regarding priority. However, the present application relies on priority from Japanese Patent Application No. 242059/2000, the certified copy of which has already been filed and acknowledged.

Objection to Drawings

The drawings were objected to under 37 C.F.R. 1.84(p) (5) because they do not include the reference signs mentioned in the description.

However, there are no reference signs mentioned in the description for the drawings of Figs. 1 and 2.

The only reference numerals (1) and (2) mentioned in the description in regard to Figs. 1 and 2, occurs at pages 4-8. However, these do not refer to steps in Figs. 1 and 2. Rather, (1) refers to a first embodiment of Fig. 1 and (2) refers to a second embodiment of Fig. 2.

However, in order to provide better correlation between the method steps of Figs. 1 and 2, the specification (starting at page 4, line 20) and the drawings of Figs. 1 and 2 have both been

amended to specifically recite reference signs 101-105. No new matter is presented herein.

It was further stated that Figs. 1 and 2 contradict each other. However, Fig. 1 refers to a first embodiment and Fig. 2 refers to a second embodiment.

Thus, in Fig. 1, which corresponds to the first embodiment (see also original claim 2), if the customer has not selected a gift, that is, has not communicated with the administrator regarding a gift, the administrator sends an enquiry to the customer regarding whether this customer intends to choose a thank-you gift and whether the customer will communicate this choice to the administrator. As stated at page 5, lines 2-6 of the specification, "the administrator makes an enquiry to the customer, based on an output signal from a computer, about whether this customer intends to receive a thank-you gift or not and the name or number of a chosen thank-you gift if the customer plans to receive the thank-you gift." See also page 5, lines 15-17 of the specification.

However, in Fig. 2, which corresponds to the second embodiment (see also original claim 4), if the customer has not selected a gift, that is, has not communicated with the administrator regarding a gift, the administrator chooses a gift (without the customer's input) and sends or dispatches the gift to the customer. As stated at page 5, lines 11-14, the

administrator "has a thank-you gift, chosen by the thank-you gift information administrator, dispatched to this customer based on an output signal from a computer." See also page 5, lines 18-20 of the specification.

Thus, there is no contradiction between Figs. 1 and 2.

As to the different terminology used in Figs. 2 and 3, Fig. 2 has been amended to change reference from "CUSTOMER INFORMATION ADMINISTRATOR" to -- THANK-YOU GIFT INFORMATION ADMINISTRATOR --, in conformance with Fig. 3.

The drawings were further objected to under 37 C.F.R. 1.83(a) as not showing the step in claims 2 and 4 of making an enquiry.

However, it is submitted that this step is shown in Fig. 1, corresponding to the first embodiment (1). Specifically, step 104 provides this step. In order to make this step clearer, however, step 104 has been amended to recite the step of "MAKING AN ENQUIRY TO THE CUSTOMER."

In addition, Fig. 3 has been amended to delete the lead line 2 from THANK-YOU GIFT DISPATCH AGENT to HOST OF CEREMONY OR EVENT ..., and instead, to move the lead line 2 from HOST OF CEREMONY OR EVENT ... to THANK-YOU GIFT DISPATCH AGENT. This is consistent with step or process 2 recited at page 3, lines 7-11 of the specification.

The Examiner is requested to approve the above amendments to

Figs. 1-3.

Also enclosed are Replacement Sheets and an Annotated Sheets Showing Changes for Figs. 1-3.

It is therefore submitted that the objection to the drawings has been overcome.

Claim Objections

In order to provide consistent terminology, claims 2 and 4 have been amended to refer to a "thank-you gift information administrator," which is also consistent with amended Fig. 2 and original Fig. 3. The remaining claims recite the same.

As to claim 4, the Examiner is correct in stating that the thank-you gift is chosen by the thank-you gift information administrator. This corresponds to the second embodiment of the invention in relation to Fig. 2.

However, to clarify claim 4, this claim has deleted the alternative embodiments, that is, has deleted the step of making an enquiry which is specific to the first embodiment (1) and now only refers to the second embodiment (2) where the thank-you gift information administrator chooses and dispatches a thank-you gift to the customer based on an output signal from a computer in the event that a customer fails to communicate to the thank-you gift information administrator regarding at least one of a name and a number of a chosen thank-you gift after a predetermined period of

time.

Finally, the claims have all been amended to change "order/dispatch" to --order and dispatch--.

Accordingly, it is respectfully submitted that the objections to the claims have been overcome.

Rejection of Claims under 35 U.S.C. §112, second paragraph

Claims 1, 2, 4 and 5 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

Claim 1 has been amended to delete the word "directly." This claim was intended to convey that the thank-you gift information administrator, through no intermediary party, that is, directly, gives an instruction to a thank-you gift dispatch agent based on at least one of the names and numbers of the chosen thank-you gifts so that the chosen thank-you gifts are dispatched to the customers. Claim 1 has been amended to merely recite that the customers notify a thank-you gift information administrator of at least one of names and numbers assigned to chosen thank-you gifts. Thus, claim 1 is now sufficiently broad to cover the situation where this occurs directly (without any intermediary party), as well as through a management of a site of the event.

As to claim 2, the limitations thereof have been incorporated into claim 1. The last part of "at least one of the

name and number of a chosen thank-you gift if the customer intends to receive the thank-you gift" has been deleted from the claim, and the last step in claim 2 (now in claim 1) has been reworded to make reference specifically to the first embodiment (1) of Fig. 1 of "making an enquiry to the customer by the thank-you gift information administrator of whether the customer intends to receive a thank-you gift or not in the event that a customer fails to communicate regarding at least one of the name and number of a chosen thank-you gift even after a predetermined period of time, based on an output signal from a computer.

As to claim 4, the last step has been amended to recite the step of "in the event that a customer fails to communicate to the thank-you gift information administrator regarding at least one of a name and a number of a chosen thank-you gift after a predetermined period of time:

having the thank-you gift information administrator choose a thank-you gift for the customer, and causing a thank-you gift chosen by said thank-you gift information administrator to be dispatched to the customer based on an output signal from a computer."

Thus, as a result of the thank-you gift chosen by the thank-you gift information administrator, the gift is caused to be dispatched to the customer. This, is preferably by the dispatch agent, as per step 3 of Fig. 3 (page 3, lines 11-14).

Further, as to claim 2, the step of storing information therein has been deleted and moved to claim 1. In addition, claim 1 has been amended to recite that the thank-you gift information administrator gives an instruction with a designation of names and addresses of customers to a thank-you gift dispatch agent based on at least one of the names and numbers of the chosen thank-you gifts so that the chosen thank-you gifts are dispatched to the customers.

Claims 1 and 4 now thereby further define this by reciting how the thank-you gift information administrator obtains these names and addresses, that is, by storing information regarding at least addresses and names of the customers in a computer memory in advance. Thus, claims 1 and 4 further define the specific manner in which the thank-you gift information administrator obtains these names and addresses.

As to claim 5, this claim has been deleted since the process is stopped in claim 4 when the thank-you gift information administrator causes the thank-you gift to be dispatched to the customer.

Accordingly, it is respectfully submitted that the rejection of claims 1, 2, 4 and 5 under 35 U.S.C. §112, second paragraph, has been overcome.

Rejection of Claims under 35 U.S.C. §101

Claims 1 and 4 were rejected under 35 U.S.C. §101.

As to claim 1, the rejection was based on the fact that there is no name and address information collected for customers, and it is not clear how the gift gets to the customer because there is no name and address information.

As stated above, the step of storing information regarding at least names and addresses of the customers in a computer memory in advance by the thank-you gift information administrator, has been moved from claim 2 to claim 1, thereby satisfying this requirement and overcoming the rejection of claim 1, as suggested by the Examiner.

As to the rejection of claim 1 on the ground that the claimed invention is non-statutory since it provides for several steps that do not use technology, the Examiner is referred to MPEP 2106. First, under the decision of State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 U.S.P.Q. 2nd 1596 (Fed. Cir. 1998), the present invention is not a mere abstract idea. Rather, it produces a "useful, concrete and tangible result," as also referred to in MPEP 2106 (page 2100-6). In other words, the present invention has "real world" value, as opposed to be merely an idea of concept.

In any event, claim 1 has now been amended to incorporate a computer therein, by reciting the step of "storing information

regarding at least names and addresses of the customers in a computer memory in advance by said thank-you gift information administrator." Thus, claim 1 now recites "the use of technology."

Claim 4 was rejected on the same basis as claim 1. However, claim 4 recites the storage of names and addresses in a computer memory, as now recited in claim 1. In any event, for the same reasons given above as to claim 1, it is submitted that claim 4 is directed to statutory subject matter.

Accordingly, it is respectfully submitted that the rejection of claims 1 and 4 under 35 U.S.C. §101 has been overcome.

Prior Art Rejections

Claims 1-14 were rejected under 35 U.S.C. §103(a) as being obvious from U.S. Patent No. 5,915,244 to Jack et al.

The limitations of claim 2 have been incorporated into claim 1 corresponding to the first embodiment of Fig. 1, and claim 4 is in independent form corresponding to the second embodiment of Fig. 2.

Claim 1

In the first place, it is noted that claims 1 and 4 both recite the step of first distributing books of thank-you gifts to customers attending an event, the books including at least one of

names and numbers assigned to chosen thank-you gifts. It is important to note that the books are distributed at an event. As discussed at page 1 of the present application, this can be a wedding ceremony, a funeral, a celebration, etc. where it is desirable to give the attendees a gift.

To the contrary, in Jack et al, each person must earn points which are redeemable towards an award. Thus, the person does not receive a gift, but rather, earns a reward. See, for example, column 7, lines 26-39 and column 8, lines 13-18. Further, there is no event that the person attends in which the people receive books of thank-you gifts.

In this regard, the first step of each of claims 1 and 4 is not disclosed or even remotely suggested by Jack et al.

Further, the limitations of claim 2 have been incorporated into claim 1, and claim 2 has been canceled. Thus, claim 1 now covers the situation where an enquiry is made to the customer by the thank-you gift information administrator of whether the customer intends to receive a thank-you gift or not in the event that a customer fails to communicate regarding at least one of the name and number of a chosen thank-you gift even after a predetermined period of time, based on an output signal from a computer. Further, this step added to claim 1 of making an enquiry to the customer by the thank-you gift administrator, is based on an output signal from a computer.

In Jack et al, since there is only a reward system based on earnings, the customer must ask for a reward. If the customer does not ask for a reward, no enquiry is made by anyone to the customer to determine if the customer intends to receive a thank-you gift or not. Rather, the customer merely does not receive a reward.

In Jack et al, although program participants may be asked to redeem earnings "by the end of the program" (column 5, lines 30-31), no enquiry is made as to whether or not the customer intends to receive a gift, as recited in amended claim 1.

Thus, Jack et al fails to disclose or even remotely suggest the following limitations in amended claim 1:

a) first distributing books of thank-you gifts to customers attending an event;

b) making an enquiry to the customer by the thank-you gift information administrator of whether the customer intends to receive a thank-you gift or not in the event that a customer fails to communicate regarding at least one of the name and number of a chosen thank-you gift even after a predetermined period of time; and

c) making this enquiry, based on an output signal from a computer. In other words, this is an automatic process.

Claim 3

Since claim 3 depends from claim 2, the same remarks made above in regard to claim 2 apply equally to claim 3.

As with claim 2, the step of stopping the administrative process regarding the customer, by the thank-you gift information administrator if the customer still fails to reply within a certain period, is based on an output signal from the computer.

Claim 4

Claim 4 covers the second embodiment of the invention shown in Fig. 2.

Claim 4 includes the same first step as claim 2, and therefore, the same remarks apply.

However, claim 4 covers the situation where the thank-you gift is chosen by the thank-you gift information administrator to be dispatched to the customer based on an output signal from a computer in the event that a customer fails to communicate to the thank-you gift information administrator regarding at least one of a name and a number of a chosen thank-you gift after a predetermined period of time.

In order to make this absolutely clear, the last step of claim 4 has been amended to recite:

"in the event that a customer fails to communicate to the thank-you gift information administrator regarding at least one

of a name and a number of a chosen thank-you gift after a predetermined period of time:

having the thank-you gift information administrator choose a thank-you gift for the customer, and

causing a thank-you gift chosen by said thank-you gift information administrator to be dispatched to the customer based on an output signal from a computer."

There is no disclosure or even a remote suggestion in Jack et al of having anyone other than the customer choose a gift. If the customer does not choose a gift, the customer does not receive a gift.

With claim 4, the administrator chooses the gift for the customer and then has the gift dispatched to the customer.

The Examiner has failed to show anywhere in Jack et al where these claim limitations are disclosed or even remotely suggested. Rather, the Examiner merely refers to a step of "dispatching" in general terms (see page 13 of the Office Action). There is nowhere disclosed in the Office Action that Jack et al has the administrator choose the gift for the customer if the customer does not choose a gift within a predetermined time period, as claimed in claim 4.

Claims 6 and 12

These claims recite that the books to be distributed are

different from each other in terms of one of prices of the thank-you gifts and price ranges of the thank-you gifts.

The Examiner states that Jack et al discloses that catalogs to be distributed are different from each other in terms of prices of the gifts or price ranges of the gifts.

However, Jack et al merely prints one catalog with different items at different prices. This is different from distributing books having different price gifts and different price ranges of gifts.

For example, as recited in the last paragraph on page 8 of the present application, a book A contains thank-you gifts whose value is in a range from a_1 to a_2 dollars, a book B contains thank-you gifts whose value ranges from b_1 dollars to b_2 dollars, and a book C contains thank-you gifts whose value ranges from c_1 dollars to c_2 dollars, and the books to be distributed to the customers are selected in accordance with the amounts of money given by the customers.

As recited at page 9, lines 2-4 of the present application, selection as such makes it possible to provide thank-you gifts whose monetary values are proportioned approximately to the amounts of money given by the customers.

This is very different from providing a single book with different values. Jack et al does not disclose or even remotely suggest that catalogs are different from each other in terms of

prices of the gifts or price ranges of the gifts.

Jack et al merely discloses the meaning of award levels associated with twenty award points, etc. (column 5, lines 1-3) and that the award level of each catalog item is shown next to a picture of the item (column 7, lines 15-18), so that participants do not have to reference a separate price list.

Thus, this claimed aspect is nowhere disclosed or suggested by Jack et al.

Claims 7 and 13

These claims recite the step of classifying thank-you gift dispatch agents by region.

The Examiner states that Jack et al discloses that:

- 1) gifts may be shipped to various states and countries,
- 2) particular instructions to warehouses and delivering couriers,
- 3) the system calculates shipping costs and incorporates them into the price ranges and plateau pricing for the catalog gifts, and
- 4) customers may call the toll-free number of a remote redemption center responsible for mailing awards to participants.

However, there is no disclosure or a remote suggestion from these aspects 1) - 4) that the thank-you gift dispatch agents are classified by region which work with a thank-you gift information

administrator.

In Jack et al, aspects 1) - 4) above do not regulate the relation between a thank-you gift administrator and thank-you gift dispatch agents.

Claims 8 and 14

These claims recite the step of providing thank-you gift dispatch agents which are different from each other in accordance with the types of thank-you gifts.

Thus, as recited in the specification starting at page 9, line 21, different dispatch agents are engaged together in accordance with the types of thank-you gifts. Thus, for example, a dispatch agent A is used for garments, a dispatch agent B is used for furniture, a dispatch agent C is used for foodstuffs, and a dispatch agent D is used for personal items. Based on instructions given from a thank-you gift information administrator, requested thank-you gifts are dispatched to customers in accordance with instructions from a computer.

The Examiner asserts that employees may be given gifts according to their performance, and describes various examples regarding the above assertion. However, even considering the assertion by the Examiner, Jack et al does not even remotely suggest the relation between the thank-you gift information administrator and the thank-you gift dispatch agents such that

there is a difference in thank-you gift dispatch agents in accordance with the types of gifts.

Accordingly, it is respectfully submitted that the rejection of claims 1-14 under 35 U.S.C. §103(a) has been overcome.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

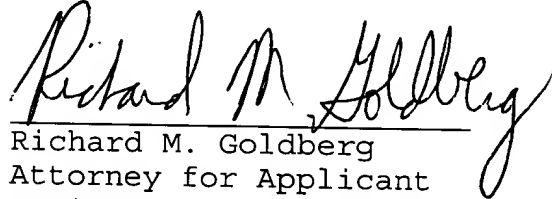
In the event that this Paper is late filed, and the necessary petition for extension of time is not filed concurrently herewith, please consider this as a Petition for the requisite extension of time, and to the extent not tendered by check attached hereto, authorization to charge the extension fee, or any other fee required in connection with this Paper, to Account No. 07-1524.

The Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1524.

In view of the foregoing amendments and remarks, it is respectfully submitted that Claims 1, 3, 4, 6-8 and 12-14 are

allowable, and early and favorable consideration thereof is solicited.

Respectfully submitted,

A handwritten signature in cursive script, reading "Richard M. Goldberg". The signature is written in dark ink and is positioned above a horizontal line.

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